Remarks

This paper is submitted in response to the Office Action dated April 3, 2001, within the three month period for response. Reconsideration and allowance of all pending claims by the Examiner are respectfully requested.

In the subject Office Action, claims 38-74 were rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 6,006,034 to Heath et al. (hereinafter "Heath") in view of U.S. Patent No. 6,044,382 to Martino (hereinafter "Martino").

Applicants respectfully traverse the Examiner's rejections to the extent that they are maintained.

Turning first to the rejection of claim 38, this claim recites an apparatus including a processor, a memory and a computer program commencing to download a file referencing a plurality of components, said computer program dynamically prompting a user to select which of said plurality of components to download.

The Examiner's new rejection (which is now the third separate basis of rejection for this claim since the claim was presented in the Amendment and Response filed November 19, 1999) is based on the combination of Heath and Martino. In particular, the Examiner relies on col. 4, lines 28-48 of Heath for allegedly disclosing a processor, memory and computer program that commences to download a file referencing a plurality of components. The Examiner admits that Heath fails to disclose a computer program that dynamically prompts a user to select which of the plurality of components to download; however, the Examiner relies on Martino, in particular the disclosure at col. 17, line 65 to col. 18, line 17, to allegedly disclose a server that automatically prompts a user with a download parameter streams command so the user can load into form/menu memory from an external source the desired streams of menu and form data.

Applicants respectfully submit, however, that the Examiner's rejection fails to establish a *prima facie* case of obviousness as to claim 38, and thus, claim 38 is allowable over the prior art of record. In particular, it appears the Examiner has improperly relied on hindsight in making the rejection, as no objective evidence of motivation has been

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presented to support the Examiner's contention that one of ordinary skill in the art would be motivated to modify Heath using Martino to render claim 38 obvious.

First, as to Heath, this reference discloses a mechanism for updating components of an executable application, which may include executable codes, library files, parameter files, and data files (col. 1, lines 60-62). Version information is maintained for both the components of a previously-downloaded version of an application and any new or modified components to be used in updating the downloaded version of the application.

As admitted to by the Examiner, Heath does not disclose dynamically prompting a user as to which components of an application should be downloaded. In contrast, a downloadable catalog file is used by a client computer in Heath to determine which components need to be downloaded when updating an application. Such a configuration is entirely logical in a system such as Heath, since application components are typically designed specifically to work together in a particular manner. Were a user given the opportunity to select which components should be downloaded, it is entirely possible that inconsistent components could be utilized together, causing an application to crash and/or develop incorrect and/or indeterminate results.

Thus, it should be evident from Heath that user participation in a determination of what application components should be downloaded during an update would be entirely inconsistent with the goals and objectives of the automated application update process disclosed in Heath.

In addition, contrary to the Examiner's position, Martino would not motivate one of ordinary skill in the art to incorporate user participation into the Heath application update process. Specifically, the cited passage at cols. 17-18 of Martino refers to an initial download of a set of forms into a local memory 96 (Fig. 6) that configure a data transaction assembly server (TAS) for use in a particular application. However, as discussed starting at col. 18, line 18, once the set of forms is downloaded, it appears the forms are retrieved from the local memory in response to user input, and not downloaded, as apparently alleged by the Examiner.

Other passages in Martino, e.g., at col. 6, arguably suggest downloading additional menus and forms after a user inputs data into a form and sends the form back to a central server. Nonetheless, this suggestion is insufficient to motivate one of ordinary skill in the art to modify Heath to incorporate dynamic prompting of a user. It is well settled that a proposed modification to the teachings of a prior art reference cannot render that reference unsatisfactory for its intended purpose or change the principle of operation of that reference. MPEP §§2143.01 and 2145.X.D.

Here, modifying Heath to prompt a user as to which components should be downloaded runs expressly counter to the goals and objectives of Heath.

First, dynamically prompting a user to select application components in Heath to download would in the least significantly alter the purpose and use of a catalog file, and at the most, eliminate the need to incorporate versioning information in a catalog file, as is disclosed in Heath. In either event, the principle of operation of the Heath arrangement would be significantly different, as the decision on what components needed to be downloaded in order to properly update an application would be <u>shifted</u> from the application provider to the end user.

Second, dynamically prompting a user to select application components would introduce the possibility of human error, and the attendant risk that incompatible application components from different versions of an application would be installed in a client computer. Given the strong desire in Heath of maintaining the integrity and authenticity of an application (see, e.g., col. 2, lines 37-45), any attempt to relinquish control over what components are downloaded would effectively render the Heath system <u>unsatisfactory</u> for its intended purpose of providing reliable updates to an application program.

Third, one goal of Heath is minimizing processing overhead and user involvement through automating an application update process to the greatest extent possible. See, e.g., col. 1, lines 50-55 ("By intelligently and automatically selecting to download and update only the needed and changed components of an application program, the present

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method alleviates the concerns of time and efficiency in any client-server network environment which requires highly dynamic application updates."). Adding user prompting to such a scenario would not be consistent with these goals, and as such Applicants respectfully submit that there would be no motivation for one of ordinary skill in the art to modify Heath to incorporate dynamic prompting of a user.

Applicants respectfully submit that the only motivation relied upon by the Examiner in combining Heath and Martino comes from Applicants' disclosure, and as such, constitutes the use of improper hindsight. Accordingly, Applicants submit the Examiner has failed to raise a *prima facie* case of obviousness as to claim 38. Reconsideration and allowance of claim 38, as well as claims 39-49 which depend therefrom, are therefore respectfully requested.

Moreover, with respect to independent claims 50 and 61, each of these claims likewise recite the dynamic prompting of a user to select components referenced by a downloaded file or document for downloading. Accordingly, for the same reasons presented above with respect to claim 38, the Examiner has failed to establish a *prima facie* case of obviousness as to claims 50 and 61. Reconsideration and allowance of claims 50 and 61, as well as claims 51-60 and 62-72 which depend therefrom, are therefore respectfully requested.

Next, with respect to claims 73 and 74, each of these claims also recite the concept of dynamically prompting of a user to select components referenced by a downloaded file or document for downloading. Thus, for the reasons presented above with respect to claim 38, the Examiner has also failed to establish a *prima facie* case of obviousness as to claims 73 and 74.

In addition, each of claims 73 and 74 recite that the document being downloaded is an HTML document.

Moreover, with respect to claim 74, this claim recites that the components are embedded components referenced by the HTML document. Claim 74 also recites parsing the HTML document for such references.

Heath, on the other hand, is directed to application components referenced by a catalog file, none of which are disclosed as HTML documents. Heath does disclose providing a link to a catalog file and/or a launcher application in an HTML document (see, e.g., cols. 7-8), yet neither the catalog file, nor any of the application components, are disclosed to be HTML compatible.

Likewise, Martino discloses a form-based system, and does not disclose the use of HTML documents as contemplated by the invention. Furthermore, with regard specifically to claim 74, it appears the "references" in the forms used in the Martino reference are to <u>other</u> forms or menus, and not embedded components of an HTML document. Thus, it does not appear Martino adds further to the rejection in this regard.

Accordingly, Applicants submit that Heath and Martino fail to disclose or suggest claims 73 and 74. Reconsideration and allowance of these claims are therefore respectfully requested.

With regard to the various dependent claims, Applicants note the Examiner has rejected a number of these claims without pointing to specific disclosure in the cited references that establish the obviousness of the specific features recited in those claims. Nonetheless, in the interest of prosecutorial economy, the rejections of these claims will be traversed simply on the basis of the aforementioned patentability of the base independent claims from which these claims depend. Applicants maintain the right to traverse the rejections of these claims individually in future papers.

As a final matter, Applicants have added new claim 75, support for which may be found, for example, in Figs. 3 and 5 as filed. This claim adds, to the features recited in claim 38, the additional features of (1) receiving user input that selects at least one of the plurality of components, (2) commencing to download at least one selected component from the plurality of components, and (3) displaying the file with the selected component embedded therein. Given that Heath is directed to application components, and that Martino appears to disclose the download of other forms or menus in response to user input, Applicants respectfully submit that neither reference, alone or in combination,
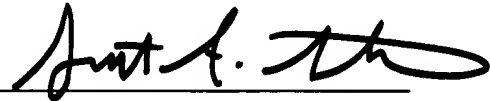
discloses or suggests the display of downloaded components embedded in a document subsequent to dynamic prompting that selects such components. Consideration and allowance of claim 75 are therefore respectfully requested.

In summary, Applicants respectfully submit that all pending claims are novel and non-obvious over the prior art of record. Reconsideration and allowance of all pending claims are therefore respectfully requested. If the Examiner has any questions regarding the foregoing, or which might otherwise further this case onto allowance, the Examiner may contact the undersigned at (513) 241-2324. Moreover, if any other charges or credits are necessary to complete this communication, please apply them to Deposit Account 23-3000.

Respectfully submitted,

3 JULY 2001

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